

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JEFFREY SCHWINDT, MICHAEL E. MILLER, JOSEPH L. MARK,
JOHN P. HANCOCK and CHARLES BUTCHER

Junior Party
(Application No. 10/936,395),
v.

MICHAEL E. MILLER, JOSEPH L. MARK,
JOHN P. HANCOCK and CHARLES BUTCHER

Senior Party
(Patent No. 6,758,824).

Patent Interference No. 105,805 (SCM)
(Technology Center 3700)

DECLARATION – Bd. R. 203(b)¹

Part A. Declaration of Interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent, count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

¹ “Bd. R. x” may be used as shorthand for “37 C.F.R. § 41.x”. 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1 **Part B. Judge managing the interference**

2 Administrative Patent Judge Sally C. Medley has been designated to manage
3 the interference. Bd. R. 104(a).

4 **Part C. Standing order**

5 A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this
6 DECLARATION. The STANDING ORDER applies to this interference. The
7 STANDING ORDER has recently been updated. An Executive Summary of
8 significant changes is provided.

9 **Part D. Initial conference call**

10 A telephone conference call to discuss the interference is set for **1:30 p.m.**
11 **on 12 July 2011** (the Board will initiate the call). The interference is declared to
12 resolve an apparent inventorship dispute. *Chou v. University of Chicago*, 254, F.3d
13 1347, 1358 n.2 (Fed. Cir. 2001) (one means for a putative inventor to assert
14 inventorship rights is to file a patent application and have the PTO declare an
15 interference to establish inventorship). The parties should be prepared to discuss,
16 during the conference call, why any issues other than inventorship should be
17 considered.

18 No later than **four business days** prior to the conference call, each party
19 shall file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd.R. 120; Bd.R. 204;
20 SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

21 A sample schedule for taking action during the motion phase appears as
22 Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the
23 schedule prior to the conference call and to agree on dates for taking action. A
24 typical motion period lasts approximately eight (8) months. Counsel should be
25 prepared to justify any request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Named Inventors: JEFFREY SCHWINDT, Indianapolis, IN
MICHAEL E. MILLER, Trafalgar, IN
JOSEPH L. MARK, Indianapolis, IN
JOHN P. HANCOCK, Fishers, IN
CHARLES BUTCHER, Carmel, IN

Involved Application: Application 10/936,395, filed 8 September 2004

Title: Biopsy apparatus

Assignee: Tissue Extraction Devices, LLC

Senior Party

Named Inventors: MICHAEL E. MILLER, Trafalgar, IN
JOSEPH L. MARK, Indianapolis, IN
JOHN P. HANCOCK, Fishers, IN
CHARLES BUTCHER, Carmel, IN

Involved Patent: Patent No. 6,758,824 issued 6 July 2004, based on
Application 09/707,022, filed 6 November 2000

Title: Biopsy apparatus

Assignee: Suros Surgical Systems, Inc.

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd.R. 154(c)(1); SO ¶ 154.2.1. The senior party is responsible for initiating settlement discussions. SO ¶ 126.1.

Part F. Count and claims of the parties

Count 1

Claim 1 of Schwindt's Application or Claim 1 of Miller's Patent

Count 2

Claim 2 of Schwindt's Application or Claim 2 of Miller's Patent

1	<u>Count 3</u>
2	Claim 3 of Schwindt's Application or Claim 3 of Miller's Patent
3	<u>Count 4</u>
4	Claim 4 of Schwindt's Application or Claim 4 of Miller's Patent
5	<u>Count 5</u>
6	Claim 5 of Schwindt's Application or Claim 5 of Miller's Patent
7	<u>Count 6</u>
8	Claim 6 of Schwindt's Application or Claim 6 of Miller's Patent
9	<u>Count 7</u>
10	Claim 7 of Schwindt's Application or Claim 7 of Miller's Patent
11	<u>Count 8</u>
12	Claim 8 of Schwindt's Application or Claim 8 of Miller's Patent
13	<u>Count 9</u>
14	Claim 9 of Schwindt's Application or Claim 9 of Miller's Patent
15	<u>Count 10</u>
16	Claim 10 of Schwindt's Application or Claim 10 of Miller's Patent
17	<u>Count 11</u>
18	Claim 11 of Schwindt's Application or Claim 11 of Miller's Patent
19	<u>Count 12</u>
20	Claim 12 of Schwindt's Application or Claim 12 of Miller's Patent
21	<u>Count 13</u>
22	Claim 13 of Schwindt's Application or Claim 13 of Miller's Patent
23	<u>Count 14</u>
24	Claim 14 of Schwindt's Application or Claim 14 of Miller's Patent
25	<u>Count 15</u>
26	Claim 15 of Schwindt's Application or Claim 15 of Miller's Patent
27	<u>Count 16</u>

1	Claim 16 of Schwindt's Application or Claim 16 of Miller's Patent
2	<u>Count 17</u>
3	Claim 17 of Schwindt's Application or Claim 17 of Miller's Patent
4	<u>Count 18</u>
5	Claim 18 of Schwindt's Application or Claim 18 of Miller's Patent
6	<u>Count 19</u>
7	Claim 19 of Schwindt's Application or Claim 19 of Miller's Patent
8	<u>Count 20</u>
9	Claim 20 of Schwindt's Application or Claim 20 of Miller's Patent
10	<u>Count 21</u>
11	Claim 21 of Schwindt's Application or Claim 21 of Miller's Patent
12	<u>Count 22</u>
13	Claim 22 of Schwindt's Application or Claim 22 of Miller's Patent
14	<u>Count 23</u>
15	Claim 23 of Schwindt's Application or Claim 23 of Miller's Patent
16	<u>Count 24</u>
17	Claim 24 of Schwindt's Application or Claim 24 of Miller's Patent
18	<u>Count 25</u>
19	Claim 25 of Schwindt's Application or Claim 25 of Miller's Patent
20	<u>Count 26</u>
21	Claim 26 of Schwindt's Application or Claim 26 of Miller's Patent
22	<u>Count 27</u>
23	Claim 27 of Schwindt's Application or Claim 27 of Miller's Patent
24	<u>Count 28</u>
25	Claim 28 of Schwindt's Application or Claim 28 of Miller's Patent
26	<u>Count 29</u>
27	Claim 29 of Schwindt's Application or Claim 29 of Miller's Patent

Count 30

Claim 30 of Schwindt's Application or Claim 30 of Miller's Patent

Count 31

Claim 31 of Schwindt's Application or Claim 31 of Miller's Patent

Count 32

Claim 32 of Schwindt's Application or Claim 32 of Miller's Patent

Count 33

Claim 33 of Schwindt's Application or Claim 33 of Miller's Patent

Count 34

Claim 34 of Schwindt's Application or Claim 34 of Miller's Patent

Count 35

Claim 35 of Schwindt's Application or Claim 35 of Miller's Patent

Count 36

Claim 36 of Schwindt's Application or Claim 36 of Miller's Patent

Count 37

Claim 37 of Schwindt's Application or Claim 37 of Miller's Patent

The claims of the parties are:

Schwindt: 1-37

Miller: 1-37

The claim of the party that is found in each count is that party's claim that corresponds to that particular count. For example, claim 1 of the involved application and claim 1 of the involved patent corresponds to Count 1, claim 2 of the involved application and claim 2 of the involved patent corresponds to Count 2, claim 3 of the involved application and claim 3 of the involved patent corresponds to Count 3, and so forth.

1 The claims of the parties which do not correspond to Counts 1-37 are:

2 Schwindt: none

3 Miller: none

4 The parties are accorded the following benefit for Counts 1-37:

5 Schwindt: none

6 Miller: none

7

1 **Part G. Heading to be used on papers**

2 The following heading must be used on all papers filed in this interference,
3 see SO ¶ 106.1.1:

4 UNITED STATES PATENT AND TRADEMARK OFFICE
5

6 _____
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9 _____

9 JEFFREY SCHWINDT, MICHAEL E. MILLER, JOSEPH L. MARK,
10 JOHN P. HANCOCK and CHARLES BUTCHER

11 Junior Party
12 (Application No. 10/936,395),
13 v.

14 MICHAEL E. MILLER, JOSEPH L. MARK,
15 JOHN P. HANCOCK and CHARLES BUTCHER

16 Senior Party
17 (Patent No. 6,758,824).
18 _____

19 Patent Interference No. 105,805 (SCM)
20 (Technology Center 3700)
21 _____
22

23 **Part H. Order form for requesting file copies**

24 When requesting copies of files, use of SO Form 4 will greatly expedite
25 processing of the request. Please attach a copy of Parts E and F of this
26 DECLARATION with a hand-drawn circle around the patents and applications for
27 which a copy of a file wrapper is requested.

28 /Sally C. Medley/
29 Administrative Patent Judge
30

1 Enc:

2 Copy of STANDING ORDER (March 2011)
3 Copy of Executive Summary of STANDING ORDER
4 Copy of claims of Application 10/936,395
5 Copy of Patent 6,758,824
6 Copy of Form PTO-850

7
8
9 cc (via overnight delivery):

10 Attorney for Schwindt:

11 IP Advisors
12 Christopher Haigh
13 150 N. Michigan Ave.
14 STE. 2800
15 CHICAGO IL 60601
16

17 Attorney for Miller:

18 KRISTIN L. MURPHY, ESQ
19 RADER, FISHMAN & GRAUER PLLC
20 39533 WOODWARD AVENUE, SUITE 140
21 BLOOMFIELD HILLS, MI 48304